

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM DERE and SUE W. DERE

Appeal 2007-1746
Application 09/621,400
Technology Center 2100

Decided: September 17, 2007

Before JOSEPH L. DIXON, ANITA PELLMAN GROSS
and ALLEN R. MacDONALD, *Administrative Patent Judges*.
DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the
Examiner's Final Rejection of claims 1-4, 6, 7, 9-13, 17, 22, 24, 25, and
39-41.

We REVERSE.

BACKGROUND

Appellants' invention relates to a method and apparatus for management of an automated license installation. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of managing an automated license installation on a client computing system, the method comprising the steps of:

retrieving license information of the client computing system from a license database located on a remote server;

receiving a selection of a configuration of the retrieved license information;

confirming the configuration of the retrieved license information on the client computing system; and

receiving one of a license file relating to the confirmed configuration of the retrieved license information and an error message.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Coley	US 2005/0273436 A1	Dec. 08, 2005
Nabahi	US 6,006,035	Dec. 21, 1999

REJECTIONS

Claims 1-4, 6-7, 11-13, and 39-41, are rejected under 35 U.S.C. 102(e) as being anticipated by Coley. Claims 9-10, 17, 22, and 24-25, are

rejected under 35 U.S.C. 103(a) as being unpatentable over Coley in view of Nabahi.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Nov. 15, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Aug. 28, 2006) and Reply Brief (filed Jan. 16, 2007) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

ANTICIPATION

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827,

1830 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

"It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002) (citations and internal quotation marks omitted). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (citations and internal quotation marks omitted).

"[A] prima facie case of anticipation [may be] based on inherency." *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product."). *See also In re Spada*, 911 F.2d 705, 708 09, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990).

From our review of the instant claims and the prior art rejection, applied by the Examiner, we will not sustain the rejection of independent claim 1. Here, the Examiner relies upon teachings in Coley that software is properly licensed (Answer 8). Additionally, the Examiner relies upon the teaching that particular features in a client application may be selectively enabled in a menu and that these selections are passed to a “Check Out License” (Answer 9-10). The Examiner thereby concludes that the software system of Coley is configurable. We cannot agree with the Examiner's interpretation of the teachings of Coley. Rather, we find that the software is configurable and that configuration is then incorporated or used in making the appropriate license.

Next, the Examiner maintains that the system of Coley teaches confirming or ensuring the configuration of the retrieved license information in a client/server installing system (Br. 10-13). Here, we find the portions of Coley relied upon by the Examiner to merely teach ensuring that software freely distributed is or will be licensed rather than a confirmation of a configuration of a selected license configuration as in a final check before the license is formed and entered on a respective machine. Here, we find that the generalized teachings regarding software applications, which require licenses, of Coley do not teach the “managing an automated license installation on a client computing system” as recited in the instant claim limitations. Therefore, we find the Examiner reliance upon the teachings of Coley to be in error, and we cannot sustain the rejection of independent claim 1 and its dependent claims based upon Coley alone.

OBVIOUSNESS

With respect to dependent claims 9 and 10, the Examiner relies upon the teachings of Nabahi to teach the detection of the operating system and use therein for setting a variable in the operating system (Answer 6-7). Appellants maintain that Nabahi does not remedy the above noted deficiency in Coley with respect to independent claim 1 (Br. 9-10). We agree with Appellants that Nabahi does not remedy the above noted deficiency in independent claim 1. From our review of Coley and Nabahi, we conclude that the Examiner has not shown that the combined teachings of Coley and Nabahi would have taught or fairly suggested the invention as recited in dependent claims 9 and 10, and we will not sustain the rejection of dependent claims 9 and 10.

With respect to independent claim 17, the Examiner relies upon the same basis as set forth with respect to independent claim 1 (Answer 7). Additionally, the Examiner maintains that teachings in Coley teach or fairly suggest the claimed:

an automated license daemon program which resides on the remote server system, the automated license daemon configured to receive the user information from the tunneling agent; and

a first database which resides on the remote server system and on which is stored license information and a license file, the first database configured to receive a request from the automated license daemon program and return a reply, the reply including one of the license information, the license file, and an error message;

wherein the automated license daemon is further configured to send a reply HTTP message based on the reply to the setup program over the network using the HTTP port.

(Claim 17 and see generally Answer 14-15).

While the Examiner's discussion of the rejection is non-existent in the statement of the rejection referencing the rejection of independent claim 1, we find the claim language of independent claim 17 is different from the language of independent claim 1. The Examiner identifies various teachings at pages 14-15 of the Answer which are correlated to the claim language. From our review of these teachings, we cannot agree with the Examiner that Coley teaches a set-up program to work with a license daemon on a server to set up a configurable license with a reply or confirmation. Therefore, we cannot sustain the rejection of independent claim 17 under 35 U.S.C. § 103(a) and its dependent claims.

CONCLUSION

To summarize, we have reversed the rejection of claims 1-4, 6, 7, 11-13, and 39-41 under 35 U.S.C. § 102. We have reversed the rejection of claims 9, 10, 17, 22, 24, and 25 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

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